

REMARKS

In the last Office Action¹, the Examiner took the following actions:

rejected claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,643,825 to Li et al. ("Li");

rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 6,470,381 to De Boor et al. ("De Boor");

rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 6,247,066 to Tanaka et al. ("Tanaka");

rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 5,754,840 to Rivette et al. ("Rivette"); and

rejected claim 17 without providing any specific grounds.

I. Rejection of claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,643,825 to Li et al. ("Li"). In order to properly establish that *Li* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites, among other things, “*determin[ing]* whether a display format of the user terminal is *dependent on an operating system* of the user terminal” (emphasis added). *Li* does not disclose at least these elements of claim 1.

The Examiner relies on *Li*’s disclosure in the background of the application:

It is known to use script languages, such as Extensible Markup Language (XML), to provide terminal emulation for legacy host based applications and the data provided by the applications. For example, data provided by host applications traditionally accessed using 3270 terminal emulation may be reformatted using XML, which can enable the data and application to be accessed via a World Wide Web (WWW) browser rather than a video terminal. (col.1, lines 14-21).

The Examiner further relies on the disclosure from the detailed description:

It will be understood that, the user and the client 115 may be remote from each other such as when the terminal emulation program 110 runs on a mid-tier server to conduct terminal emulation sessions for multiple clients (such as web browsers) running on respective client workstations. It will also be understood that the user can a web browser. (*id.* at col. 4, lines 14 - 19).

The Examiner further states that, “Applicant admits that **web formats such as HTML and XML do not depend on the OS** in Paragraph 0006 of the Specifications.” (Office Action at p. 12)(emphasis in original). The Examiner appears to contend that *Li* can use XML, and that XML does not depend on the OS and thus *Li* teaches a format that is not dependent on the OS. However, even if this were true, a point that applicants do not concede, the Examiner fails to distinguish between *using* a format that is not dependent on the OS and “*determin[ing]* whether a . . . format . . . is dependent on the operation system[.]” Thus, neither this portion of *Li*, nor any other portion of *Li*,

constitutes a teaching of “*determin[ing]* whether a display format of the user terminal is dependent on an operating system of the user terminal[.]”

Since *Li* fails to teach each and every element of claim 1, *Li* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons.

Independent claims 2 and 7, while of different scope, recite elements similar to those of claim 1 and are thus allowable over *Li* for at least the same reasons discussed above in regard to claim 1. Claims 4 and 6 are allowable at least due to their dependence from claim 1 or 2. Claims 8-10, 12, 13, and 16 are also allowable at least due to the dependence from claim 7.

II. Rejection of claim 11 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*. A *prima facie* case of obviousness has not been established with respect to this claim.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. §2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the

claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 11 depends indirectly on claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "determining whether a display format of a user terminal is dependent on an operating system of the user terminal" as recited in claim 7 and required by claim 11. Moreover, *De Boor* fails to cure the deficiencies of *Li*. That is, *De Boor* also fails to teach or suggest "determining whether a display format of a user terminal is dependent on an operating system of the user terminal[.]"

In view of the mischaracterization of the references, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 11. Thus,

the Examiner has failed to clearly articulate a reason why claim 11 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*.

III. Rejection of claims 14 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Tanaka*. A *prima facie* case of obviousness has not been established with respect to this claim.

Claim 14 depends from claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least “determining whether a display format of a user terminal is dependent on an operating system of the user terminal” as recited in claim 7 and required by claim 14. Moreover, *Tanaka* fails to cure the deficiencies of *Li*. That is, *Tanaka* also fails to teach or suggest at least “determining whether a display format of a user terminal is dependent on an operating system of the user terminal[.]”

In view of the mischaracterization of the references, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 14. Thus, the Examiner has failed to clearly articulate a reason why claim 14 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully

request that the Examiner withdraw the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Tanaka*.

IV. Rejection of claims 15 under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Rivette*. A *prima facie* case of obviousness has not been established with respect to this claim.

Claim 15 depends from claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "determining whether a display format of a user terminal is dependent on an operating system of the user terminal" as recited in claim 7 and required by claim 15. Moreover, *Rivette* fails to cure the deficiencies of *Li*. That is, *Rivette* also fails to teach or suggest at least "determining whether a display format of a user terminal is dependent on an operating system of the user terminal[.]"

In view of the mischaracterization of the references, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 15. Thus, the Examiner has failed to clearly articulate a reason why claim 15 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Rivette*.

V. Rejection of claim 17

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 17. Claim 17 is dependent upon claim 11 and it can only be assumed that claim 17 is rejected under the same grounds. A *prima facie* case of obviousness has not been established with respect to this claim.

The basis for this rejection is not made clear in the office action. The discussion of the rejection cites only to *Li*. (Office Action at pp. 11-12). Claim 17 depends indirectly on claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach at least "determining whether a display format of a user terminal is dependent on an operating system of the user terminal" as recited in claim 7 and required by claim 17.

Although the rejection of claim 17 discusses only *Li*, the discussion of claim 11, from which claim 17 depends, cites to *De Boor*. However, *De Boor* fails to cure the deficiencies of *Li* and would not render obvious the claimed invention. That is, *De Boor* also fails to teach or suggest at least "determining whether a display format of a user terminal is dependent on an operating system of the user terminal[.]"

In view of the mischaracterization of the references, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 17. Thus, the Examiner has failed to clearly articulate a reason why claim 17 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*.

Lastly, the Examiner makes numerous assertions with regard to the dependant claims under the "Response to Arguments" heading. Although Applicants do not concede these points, the Examiner's arguments fail to correct the deficiencies of *Li* as discussed above.

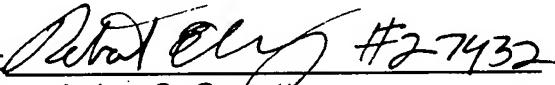
In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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